

REMARKS

Claims 1-28, 30, 34-70, 89, and 105 were previously canceled. Claims 29, 71-74, 82, 84, 88, 90-91, 98, 100, 104, 106-107, 115, 117-118, 121-122, 125 and 127 are currently amended. Claims 31-33, 75-81, 83, 85-87, 92-97, 99, 101-103, 108-114, 116, 119-120, 123-124, and 126 were previously presented. Accordingly, claims 29, 31-33, 71-88, 90-104, and 106-127 are pending examination.

Objection of Claim 127

Claim 127 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The amendment to claim 127 addresses this rejection.

Rejection of in Claims 29, 31, 32, 71, 76, 79, 80, 82 and 83 Under 35 USC §102

The amendment to claim 29 provides the clarification requested by the Examiner. In particular, claim 29 recites that a “first electrode strip extending through the mandrel slot.” McHenry does not teach an electrode strip extends through a mandrel slot and accordingly does not teach every element of claim 29. Since McHenry does not anticipate every element of claim 29, McHenry does not anticipate claim 29 or any of the claims depending from claim 29.

Rejection of Claims 33, 74, 75, and 78 Under 35 USC §103(a)

Claims 33, 74, 75, and 78 each depends from claim 29. Since claim 29 is believed to be in condition for allowance, these claims are also believed to be in condition for allowance.

Provisional Double Patenting Rejection in view of co-pending Application No.**10/484,474**

Claims 29, 31-33, 71-104, and 106-127 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 205-219 of co-pending Application No.10/484,474.

MPEP §804(I)(B)(1) provides the following:

If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer

In view of the above arguments, the ODP rejection is the only rejection remaining in this application which is the earlier filed of the two applications while the claims in co-pending Application No.10/484,474 are rejected on other grounds. As a result, the double patenting rejection should be withdrawn and the earlier-filed application should be allowed to issue as a patent without a terminal disclaimer.

Double Patenting Rejection in View of Co-pending Application No.10/665,687

Claims 29, 31-33, 71-104, and 106-127 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 43-86 of co-pending Application No.10/665,687.

Because the claims of co-pending Application No.10/665,687 have not been allowed, the Applicant respectfully respects that this application be allowed to issue without the filing of a terminal disclaimer relative to Application No.10/665,687 as can be permitted as discussed above. For instance, the Applicant respectfully requests that this application be treated as the earlier filed application under the first paragraph of MPEP §804(I)(B)(1).

In the event that a terminal disclaimer will be required, the Applicant submits the following argument. In the prosecution of U.S. Patent No. 6,670,071 (serial number 10/167,688 and called parent below), a Restriction Requirement was mailed on June 3, 2003. In response to that Restriction Requirement, this Application and Application No.10/665,687 were each filed as a Divisional of the parent application. Accordingly, Application No.10/665,687 is called the sister Application below.

The Restriction Requirement classified the claims that led to the sister application as belonging to invention I-3 which was characterized as “an electric storage battery comprising a flexible conductive tab.”

In the Restriction Requirement, the claims that led to the claims of the current application were claims 29-33 which is the reason that the above claims start with number 29. These claims were classified as belonging to invention II-1 which was characterized as “drawn to an electrode assembly comprising at least one separator strip separating the electrodes mounted on a pin.” Accordingly, the restriction Requirement argued that invention I-3 was patentably distinct from invention II-3. However, the double patenting rejection is now arguing that invention I-3 is not patentably distinct from invention II-1. As a result, the history of this application first argues that invention I-3 was patentably distinct from invention II-1 but is now arguing that invention I-3 is not patentably distinct from invention II-1. Because of the contradiction in these arguments, MPEP §804.01 prevents the application of double patenting rejections to previously restricted claims.

MPEP §804.01 also provides that the restriction against double patenting rejections does not apply under some circumstances. For instances, MPEP §804.01 the following:

the prohibition *>against< double patenting rejections under ... does not apply (when) ... The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner....

Fortunately, MPEP §804.01 also defines what is meant by the term “consonant” as follows:

In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained.

As a result, we must look at the arguments supporting the restriction in order to determine whether consonance exists. In particular, the Restriction states that the claims of invention II-1 and I-3 are related as combination and sub-combination. In support of this argument, the Restriction Requirement states the following:

the electric storage battery (claimed in U.S. Patent No. 6,670,071) does not require the particulars of the (electrode assembly) as claimed (in this application) because the electric storage battery does not require the particulars of the electrode assembly as claimed to show novelty and unobviousness. The subcombination has separate utility and can be used in a capacitor.

Since this argument still applies to claims in the pending application and the claims in U.S. Patent No. 6,670,071, the claims are consonant with the restriction made by the examiner. As a result, the prohibition against double patent rejections applies to U.S. Patent No. 6,670,071 applies and the rejection should be withdrawn.

Double Patenting Rejection in View of Co-pending Application No. 10/666,790

Claims 29, 31-33, 71-100 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 70-88 of co-pending Application No. 10/666,790.

Because the claims of co-pending Application No.10/665,687 have not been allowed, the Applicant respectfully respects that this application be allowed to issue without the filing of a terminal disclaimer relative to Application No.10/665,687 as can be permitted as discussed above. For instance, the Applicant respectfully requests that this application be treated as the earlier filed application under the first paragraph of MPEP §804(I)(B)(1).

In the event that a terminal disclaimer will be required, the Applicant submits the following argument. In the prosecution of U.S. Patent No. 6,670,071 (serial number 10/167,688 and called parent below), a Restriction Requirement was mailed on June 3, 2003. In response to that Restriction Requirement, this Application and Application No. 10/666,790 were each filed as a Divisional of the parent application. Accordingly, Application No. 10/666,790 is called the sister Application below.

The Restriction Requirement classified the claims that led to the sister application as belonging to invention I-5 which was characterized as “an electric storage battery having an electrically conductive case hermetically sealed by first and second end caps have no separate fill holes.”

In the Restriction Requirement, the claims that led to the claims of the current application were claims 29-33 which is the reason that the above claims start with number 29. These claims were classified as belonging to invention II-1 which was characterized as “drawn to an electrode assembly comprising at least one separator strip separating the electrodes mounted on a pin.” Accordingly, the Restriction Requirement argued that invention I-3 was patentably distinct from invention II-5. However, the double patenting rejection is now arguing that invention I-5 is not patentably distinct from invention II-1. As a result, the history of this application first argues that invention I-5 was patentably distinct from invention II-1 but is now arguing that invention I-5 is not patentably distinct from invention II-1. Because of the contradiction in these arguments, MPEP §804.01 prevents the application of double patenting rejections to previously restricted claims.

MPEP §804.01 also provides that the restriction against double patenting rejections does not apply under some circumstances. For instances, MPEP §804.01 the following:

the prohibition *>against< double patenting rejections under ... does not apply (when) ... The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner....

Fortunately, MPEP §804.01 also defines what is meant by the term “consonant” as follows:

In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained.

As a result, we must look at the arguments supporting the restriction in order to determine whether consonance exists. In particular, the Restriction states that the claims of invention II-1 and I-5 are related as combination and sub-combination. In support of this argument, the Restriction Requirement states the following:

the electric storage battery (claimed in U.S. Patent No. 6,670,071) does not require the particulars of the (electrode assembly) as claimed (in this application) because the electric storage battery does not require the particulars of the electrode assembly as claimed to show novelty and unobviousness. The subcombination has separate utility and can be used in a capacitor.

Since this argument still applies to claims in the pending application and the claims in U.S. Patent No. 6,670,071, the claims are consonant with the restriction made by the examiner. As a result, the prohibition against double patent rejections applies to U.S. Patent No. 6,670,071 applies and the rejection should be withdrawn.

Double Patenting Rejection in View of Co-pending Application No. 10/666,861

Claims 29, 31-33, 71-104, and 106-127 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 66-71 of co-pending Application No.10/666,861.

Because the claims of co-pending Application No.10/665,687 have not been allowed, the Applicant respectfully respects that this application be allowed to issue without the filing of a terminal disclaimer relative to Application No.10/665,687 as can be permitted as discussed above. For instance, the Applicant respectfully requests that this application be treated as the earlier filed application under the first paragraph of MPEP §804(I)(B)(1).

Double Patenting Rejection in View of U.S. Patent No. 6,670,071

Multiple claims are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 7 of U.S. Patent No. 6,670,071.

In the prosecution of U.S. Patent No. 6,670,071 (serial number 10/167,688), a Restriction Requirement was mailed on June 3, 2003. This Application was filed in response to that Restriction Requirement.

The Restriction Requirement classified the claims that led to U.S. Patent No. 6,670,071 as belonging to invention I-1 which was characterized as “an electric storage battery having a case and an electrode assembly, which includes a hollow elongate mandrel.”

In the Restriction Requirement, the claims that led to the claims of the current application were claims 29-33 which is the reason that the above claims start with number 29. These claims were classified as belonging to invention II-1 which was characterized as “drawn to an electrode assembly comprising at least one separator strip separating the electrodes mounted on a pin.” Accordingly, the restriction Requirement argued that invention I-1 was patentably distinct from invention II-1. However, the double patenting rejection is now arguing that invention I-1 is not patentably distinct from invention II-1. As a result, the history of this application first argues that invention I-1 was patentably distinct from invention II-1 but is now arguing that invention I-1 is not patentably distinct from invention II-1. Because of the contradiction in these arguments, MPEP §804.01 prevents the application of double patenting rejections to previously restricted claims.

MPEP §804.01 also provides that the restriction against double patenting rejections does not apply under some circumstances. For instances, MPEP §804.01 the following:

the prohibition *>against< double patenting rejections under ... does not apply (when) ... The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner....

Fortunately, MPEP §804.01 also defines what is meant by the term “consonant” as follows:

In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained.

As a result, we must look at the arguments supporting the restriction in order to determine whether consonance exists. In particular, the Restriction states that the claims of invention II-1 and I-1 are related as combination and sub-combination. In support of this argument, the Restriction Requirement states the following:

the electric storage battery (claimed in U.S. Patent No. 6,670,071) does not require the particulars of the (electrode assembly) as claimed (in this application) because the electric storage battery does not require the particulars of the electrode assembly as claimed to show novelty and unobviousness. The subcombination has separate utility and can be used in a capacitor.

Since this argument still applies to claims in the pending application and the claims in U.S. Patent No. 6,670,071, the claims are consonant with the restriction made by the examiner. As a result, the prohibition against double patent rejections applies to U.S. Patent No. 6,670,071 applies and the rejection should be withdrawn.

CONCLUSION

Applicant submits that the claims define patentably over the prior art and that this application is in condition for allowance. Accordingly, favorable consideration and allowance of this application is courteously requested.

The Examiner is encouraged to telephone the undersigned with any questions.



Travis Dodd
Reg. No. 42,491
Agent for Applicant(s)

Quallion LLC
P.O. Box 923127
Sylmar, CA 91392-3127
818-833-2003 ph
818-833-2065 fax
travisd@quallion.com